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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,265	07/31/2003	Avi Penner	2024750-7015284001	5488

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EXAMINER
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LAYNO, CARL HERNANDZ

ART UNIT	PAPER NUMBER
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3766

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/632,265

Applicant(s)

PENNER, AVI

Examiner

Carl H. Layno

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-19, 21-29 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 9, 24, 27, 32-35, 38 and 40 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6-8, 12-15, 17, 21, 25, 29, 31, 36, 37 and 39 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 11, 16, 18, 19, 22, 23, 26 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Acknowledgment is made of applicant's amendment, which was received by the Office on June 27, 2006.

2. Claims 10, 20, and 30 are canceled. Claims 1-9, 11-19, 21-29, and 31-40 are active.

***Claim Rejections - 35 USC § 102***

3. Upon further reconsideration of applicant's claim amendments and claim cancellations, the Examiner is withdrawing the 35 U.S.C 102(b) rejection of Schroeppel et al (US 5,749,909), which was made against claims 1-4, 6, 8, 13, 15-19, 21-23, 25, 26, 28, 31, and 36 in the last Office action.

4. However, the following new rejections are made in view of newly discovered references found during a follow up search.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 12, 13, 25, 31, 36, 37, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Penner et al (US 6,198,965).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In regard to claims 1 and 12, the Penner et al (US 6,198,965) patent describes an acoustic telemetry system and method for monitoring a rejection reaction of a transplanted organ whose components appear to read upon applicant's claimed features. Applicant's attention is directed to Fig.11, which shows an implanted stimulator including a transducer **106** for converting acoustic waveforms into an electric current which directly feeds two stimulation electrodes **108** through a current source **125**.

In regard to claims 1, 13, and 31, the electrodes **108** deliver current to a transplanted organ (col.14, lines 59-60), which appears to be the heart. See Fig.12.

In regard to claims 25 and 36, an externally located control device **102** (Fig.10) communicates with the implanted device **104** (Fig.11) via acoustic waves. Amplifiers **107** are used to control the strength of the acoustic signal being received by the transducer **106**, and hence, the strength of output currents on electrodes **108**.

In regard to claim 37, the implantable device **104** also has a “control” device **124**.

In regard to claim 39, diagnostic information is sent acoustically from implanted device **104** to control device **102**. This information is received by transducers **103** (Fig.10) and processed by conditioner **109** before being relayed to module **105** for display (col.14, lines 31-35).

7. Claims 1, 3, 6-8, 14, 15, 17, 21, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Leysieffer (US 6,198,971).

In regard to claims 1, 6, 8, and 21, the Leysieffer (US 6,198,971) patent describes an implantable hearing system **1** (Fig.1) for treating a patient’s hearing. The Leysieffer system **1** comprises a plurality of acoustic transducers **10a-10n** which convert sound into an analog signal/current, which is then digitized before being reconverted, processed, then reconverted into an analog signal for output to cochlear or brain stem stimulating electrodes **20a-20n** (col.8, lines 32-35). See Figs.3 and 4.

In regard to claims 3 and 17, the Examiner considers acoustic transducers **10a-10n** to constitute an “array” of transducers.

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In regard to claims 7 and 29, the Leysieffer device **1** includes a microcontroller **5** and a digital signal processor **141**, which perform the function of applicant's "control circuitry". Both have memory S0, S1, S2, and S3, for storing both stimulation parameters and software programs (col.8, lines 10-21 and 39-48).

In regard to claim 14, the cochlea and/or brain stem are considered to be nerve tissue (col.8, lines 32-35).

In regard to claim 15, casing **31** contains all of the elements in Figs. 1, 2, and 6 (col.10, lines 40-41).

*Allowable Subject Matter*

8. Claims 2, 4, 11, 16, 18, 19, 22, 23, 26, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

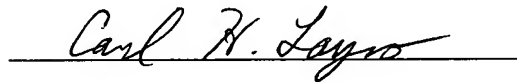
9. Claims 5, 9, 24, 27, 32-35, 38, and 40 are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (571) 272-4949. The examiner can normally be reached on 9/4/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in cursive script, reading "Carl H. Layno", is written over a horizontal line.

CARL LAYNO  
PRIMARY EXAMINER

CHL  
8/29/2006